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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------------|------------------------|
| 10/595,682 | 05/04/2006 | Uwe Schnitzler | 052460-16US M/ERB122PCUS | 4667 |
| 570 7590 10/09/2008 PANITCH SCHWARZE BELISARIO & NADEL LLP ONE COMMERCE SQUARE 2005 MARKET STREET, SUITE 2200 PHILADELPHIA, PA 19103 | | | EXAMINER SICA, VINCENT C | |
| | | | ART UNIT 3739 | PAPER NUMBER |
| | | | MAIL DATE 10/09/2008 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/595,682 | Applicant(s) SCHNITZLER, UWE | |
| | Examiner VINCENT SICA | Art Unit 3739 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05/04/2006, 06/05/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 5-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation: "wherein said welded attachment is punctate and formed by resistance welding." The meaning of the term "punctate" is unclear and lacks sufficient antecedent basis from the disclosure. The examiner recommends amending the claim using the phrase "point-wise resistance welding" as is disclosed in the specification.

Claim 6 recites the limitation: "wherein said flat body is disposed at an end of the tubule and faces away from the outlet." It is unclear whether the flat body or the tubule faces away from the outlet. The examiner recommends amending the claim to read: "wherein said flat body is disposed at an end of the tubule *that* faces away from the outlet" as is shown in Fig. 2 of the disclosure.

Claim 7 is also rejected for incorporating the above errors through dependency.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5 and 8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Schnitzler (US Pub. No. 2002/0016590 A1).

Regarding claim 1, Schnitzler teaches an instrument for plasma coagulation in Figs. 1 and 2 comprising a tubular probe body (20) with a tube wall (Fig. 1 cross-section) defining a lumen through which an inert gas is conducted through the probe body (paragraph [0027]), an ignition electrode (distal end of conducting wire 30, the cross section of which is shown in Fig. 1) located within the lumen in the region of an outlet defined by the probe body, a current conductor (30) adapted to supply a coagulation current to the ignition electrode, and a fixing device (10) fixing the ignition electrode in a predetermined position within the probe body, and comprising a flat body with longitudinal edges (26) by means of which the flat body is attached to the tube wall such that the flat body extends substantially diametrically across the lumen, and to which the ignition electrode is attached. See paragraph [0026].

Regarding claim 2 and 3, Schnitzler teaches the current conductor integrally connected to the ignition electrode by means of the flat body at point (31) on the flat body. See paragraph [0026].

Regarding claims 4 and 5, Schnitzler teaches the current conductor welded to the flat body in a punctate welded attachment (31) formed by resistance welding. See paragraph [0018].

Regarding claim 8, Schnitzler teaches a flat body comprising a flat edge between points (51') and (51'') in Fig. 4 that defines a concave cutout which faces toward the outlet.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gordon et al. (US Pat. No. 5,320,621).

Regarding claim 1, Gordon et al. teaches an instrument for plasma coagulation in Figs. 2, 5 and 6 comprising a tubular probe body (26) with a tube wall defining a lumen (43) through which an inert gas is conducted through the probe body (col. 4, lines 52-57) an ignition electrode (24) located within the lumen in the region of an outlet defined by the probe body, a current conductor (82, Fig. 11) adapted to supply a coagulation current to the ignition electrode, and a fixing device (22) fixing the ignition electrode in a predetermined position within the probe body, and comprising a flat body (legs 42, Fig. 6) with longitudinal edges (between 42 and 40) by means of which the flat body is attached to the tube wall such that the flat body extends substantially diametrically across the lumen, and to which the ignition electrode is attached (col. 4, lines 22-25 and 48-52).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon et al. (US Pat. No. 5,320,621) in view of Farin et al. (US Pat. No. 5,720,745).

Regarding claims 6 and 7, Gordon et al. does not explicitly disclose a high-temperature-resistant material within the lumen associated with the flat body. Farin et al. teaches a plasma coagulation device in Fig. 21 with a tubule (20) made of a high-temperature-resistant material (col. 6, lines 43-46) inserted into the lumen in the region of the outlet and wherein conductor (8) is disposed at the proximal (right) end of the tubule that faces away from the outlet (41), wherein the conductor comprises a flat edge (left edge) and abuts the tubule by means of sections of the flat edge. The tubule is secured against the conductor but is removable for sterilization to enable repeated use of the device (col. 6, lines 47-48). Hence, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Gordon et al. with the removable tubule of Farin et al. such that the tubule is removably secured against the flat body in order to enable sterilization of the device for repeated use.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Farin et al. (US Pat. No. 6,197,026 B1) and Goble et al. (US Pub. No. 2001/0034519 A1) disclose similar plasma coagulation systems.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VINCENT SICA whose telephone number is (571)270-5531. The examiner can normally be reached on 7:30AM to 5:00PM EST Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571)272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Vincent Sica/
10/07/08

/Michael Peffley/
Primary Examiner, Art Unit 3739